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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,701	07/03/2001	Naoki Ayai	017700-0149	8643

22428 7590 01/28/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 01/28/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/869,701

Applicant(s)

AYAI ET AL.

Examin r

Andrew T Piziali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 16-19, 21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 14, 16-19, 21 and 23-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The specification is silent regarding not removing the sheath from the end portions of the superconducting filaments.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of positive recitation is not basis for an exclusion. See MPEP 2173.05(i).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 14, 16-17, 21, 23 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,051,397 to Sato et al. (hereinafter referred to as Sato '397).

Regarding claims 14, 16-17, 21, 23 and 25-26, Sato '397 discloses an oxide superconducting wire comprising a first wire, a second wire, and a junction formed by superposing the end portions of the wires with each other (Figures 4-5 and column 3, lines 42-47). Sato '397 discloses a brazing filler metal (2) interposed between the superposed end portions of the first and second superconducting wires (Figures 4-5 and column 2, lines 49-54). Sato '397 also discloses that the bismuth oxide superconductor filaments may be coated with silver (5) (Figures 4-5 and column 5, lines 56-61).

Regarding claims 16-17, Sato '397 discloses that the superconducting wires are tape-like wires having rectangular cross sections that are bonded by superposing the wide surfaces of the tape-like surfaces (Figures 1 and 4-5, column 5, lines 13-24 and column 6, lines 25-30).

Regarding claim 21, Sato '397 discloses that the junction includes end portions so worked that the thicknesses of the wires are reduced toward the end (Figure 4).

Regarding claim 23, Sato '397 discloses that the junction is at least partially coated with a metal (6) (Figures 4-5).

Regarding claim 25, Sato '397 discloses that the superconducting wires may contain a bismuth oxide superconductor (column 3, lines 12-15).

5. Claims 14, 16-17, 21, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,358,929 to Fujikami et al. (hereinafter referred to as Fujikami).

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Regarding claims 14, 16-17, 21, and 25-26, Fujikami discloses an oxide superconducting wire comprising a first wire, a second wire, and a junction formed by superposing the end portions of the wires with each other (Figure 4 and column 2, lines 6-16). Fujikami discloses a brazing filler metal interposed between the superposed end portions of the first and second superconducting wires (column 2, lines 6-16). Fujikami also discloses that bismuth oxide superconductor filaments may be coated with silver (column 2, lines 42-63 and column 4, lines 16-29).

Regarding claims 16-17, Fujikami discloses that the superconducting wires are tape-like wires having rectangular cross sections that are bonded by superposing the wide surfaces of the tape-like surfaces (Figures 1-27).

Regarding claim 21, Fujikami discloses that the junction may have an end portions so worked that the thicknesses of the wires are reduced toward the ends (Figure 4).

Regarding claim 25, Fujikami discloses that the superconducting wires may contain a bismuth oxide superconductor (column 4, lines 16-29).

6. Claims 14, 16-19 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 5,949,131 to Sato et al. (hereinafter referred to as Sato '131).

Regarding claims 14, 16-19 and 23-26, Sato '131 discloses an oxide superconducting wire comprising a first wire, a second wire, and a junction formed by superposing the end portions of the wires with each other (Figures 24-27, column 12, lines 42-63 and column 13, lines 18-43). Sato '131 discloses a brazing filler metal interposed between the superposed end portions of the first and second superconducting wires (paragraph bridging columns 4 and 5, and

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column 8, lines 1-13). Sato '131 also discloses that bismuth oxide superconductor filaments may be coated with silver (paragraph bridging columns 1 and 2).

Regarding claims 16-17, Sato '131 discloses that the superconducting wires are tape-like wires having rectangular cross sections that are bonded by superposing the wide surfaces of the tape-like surfaces (Figures 1-36 and paragraph bridging columns 1 and 2).

Regarding claim 18, Sato '131 discloses a junction so worked that the widths of the wires are reduced towards the ends (Figures 24-27).

Regarding claim 19, Sato '131 discloses that the junction includes an end portion having a V shape in plane (Figures 26-27 and column 13, lines 28-29).

Regarding claim 23, Sato '131 discloses that the junction may be at least partially coated with a metal (Figure 17, column 11, lines 12-17, and Figure 20, column 11, lines 43-54).

Regarding claim 24, Sato '131 discloses that the junction is at least partially inserted into a material having an annular shape (Figure 20, column 11, lines 43-54).

Regarding claim 25, Sato '131 discloses that the superconducting wires may contain a bismuth oxide superconductor (column 2, lines 5-9).

Response to Arguments

7. Applicant's arguments filed 11/27/02 have been fully considered but they are not persuasive.

The applicants assert that the newly added limitation of "without removing said sheath therefrom" distinguishes the current claims over the prior art. The examiner respectfully disagrees. Sato '397 removes a portion of the sheath from the end portion of the configuration disclosed in Figure 5, but the sheath is not removed at all in Figure 4. Fujikami removes a

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portion of the sheath from the superconducting wires in some configurations, such as in Figure 10B, but in other configurations, such as Figure 4, Fujikami does not remove the sheath at all. Sato '131 removes only a portion of the sheath from the end portions of the superconducting wires (Figures 1-36). The applied prior art does not mention or suggest removing the entire sheath from the end portions of the superconducting wires.

Conclusion

8. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

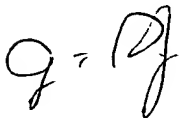
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T Piziali whose telephone number is (703) 306-0145. The examiner can normally be reached on Monday-Friday (8:00-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5665.



atp

January 10, 2003

Andrew T Piziali
Examiner
Art Unit 1775


DEBORAH JONES

SUPERVISORY PATENT EXAMINER